

REMARKS

Claims 7-13, 15-22, 24, 25 and 30-35 are pending in this application per this amendment. Claims 7, 10, 12, 13, 24, 25, 30 and 31 have been amended per the above Listing of Claims. Claims 2, 6, 23, and 26 - 29 have been canceled by way of this amendment. Claims 32 - 35 are newly added.

As amended, all claims concern compositions of the present invention that contain inorganic spherical particles selected from the group consisting of silica, boron nitride, mica, serecite, and mixtures thereof. That is, the term "substantially" has been deleted, and none of the claims now pending recite compositions containing a spherical talc particle component. In addition claim 7, which is the composition claim of broadest scope now pending in this case, includes the limitation that the inorganic spherical particle has a particle size range of from 5 microns to 25 microns. Method claim 18, which employs the compositions of claim 7, is similarly limited.

Section 112 Rejection

Claims 2, 7, 12, 13, 23, and 26 - 31 were rejected under 35 U.S.C. §112, second paragraph, the Examiner stating that the term "substantially" was a relative term, and hence was indefinite. Applicant disagrees with the position of the Examiner, for the reasons set forth in the Amendment filed May 13, 2004. However, in order to advance prosecution of this case, Applicant has amended the claims to state that the inorganic particles are "spherical" as that term is understood to one of ordinary skill in the art.

In light of the foregoing, this ground for rejection is now deemed to be moot.

Section 103 Rejections

A. The August 11, 2003 Office Action states that claims 2, 7 - 13 and 15-28 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,258,345 to Rouquest et al.

("Rouquet") in view of U.S. Patent No. 5,658,579 to LaFleur et al. ("LaFleur"). Applicant respectfully traverses this ground for rejection, for the reasons set forth below.

The Examiner states that Rouquet discloses compositions containing an elastomeric organopolysiloxane in combination with organic spherical particles. The Examiner admits, however, that Rouquet fails to teach inorganic spherical particles having the recited particle size range limitation. According to the Examiner, this deficiency of Rouquet is resolved by LaFleur, which concerns compositions comprising talc powders having specified particle size distributions.

As amended, Claim 7 concerns inorganic particles having a particle size range of from 5 microns to 25 microns that are spherical, said particles being selected from the group consisting of silica, boron nitride, mica, sericite, and mixtures thereof, to the exclusion of talc from the Markush group.

Accordingly, Applicant believes that this ground of rejection as might be applied to the present claims is moot.

B. Claims 7, 11-13, 15-20, 25, and 29 – 31 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,853,711 to Nakamura et al. ("Nakamura") in view of U.S. Patent No. 5,989,510 to Abe et al. ("Abe").

The Examiner states that Nakamura discloses water-in-oil type emulsions comprising cross-linked organopolysiloxane elastomer spherical powder having an average particle size of 2-5 microns and silica powder having an average particle size of "not more than 2 microns". The Examiner states that Nakamura fails to teach the particle size distribution of the silica powder.

Applicant submits that the Examiner's understanding of this reference is incorrect in that Nakamura does not describe silica having an average particle size of "not more than 2 microns" as stated in the Office Action at page 6, first full paragraph. Rather, the silica described in Nakamura has an average particle size of **not more than 0.2 microns**, which is a microfine,

submicron silica. See Abstract, col. 1, line 54; col. 2, lines 4 –5; col. 2, lines 19 – 20; col. 2, lines 39 – 40, and col. 3, line 13.

The Examiner, in response to Applicant's previous argument in the May 13 Amendment, states that the "average particle size does not mean the particle distribution size should be less than the claimed limitation, i.e., 1 micron of particle distribution size. The particle size distribution as recited in the instant claims refers to the uniformity rather than the actual size of the particles."

Applicant cannot agree with this characterization of the Nakamura reference. The Examiner's supposition as to what particles may constitute Nakamura's maximum average particle size of 0.2 microns is entirely speculative, and unsupported by Nakamura. The crux of the Nakamura disclosure is that microfine particles of extremely small size are essential. This is in contrast to Applicant's requirement of spherical particles of much greater size.

Applicant notes that the threshold particle size in Applicant's particle size range now recited in claim 7 is 5 microns, which is 25 times greater than the maximum average particle size limitation of 0.2 microns disclosed in Nakamura.

The Examiner cites Abe as teaching granular amorphous silica particles which are spherical and have uniform particle size distribution and filtering property. The Examiner states that Abe teaches a particle size distribution not greater than 2 and particularly not greater than 1.6 (Col. 6, lines 21-43). The Examiner states that it would have been obvious to one of ordinary skill in the art to substitute the silica in Nakamura with the Abe amorphous silica. Applicant respectfully traverses this ground of rejection as it might be made with regard to the pending claims, as amended.

Applicant submits that one of ordinary skill in the art would not look to Abe, inasmuch as there is no basis, no suggestion in the cited references, to replace the very defined microfine silica material of Nakamura with the totally different silica material identified in Abe.

As indicated above the Nakamura silica material has a maximum average particle size of 0.2 microns, which feature is a critical element of the Nakamura invention. Additionally, Nakamura's hydrophobic silica is a specially made silica material that not only is microfine, but has trimethylsilylated or dimethylsilylated hydrophilic hydroxy groups on its surface (See Col. 3, lines 11 et seq.). This adds absorption characteristics to the particles (oil and/or water, depending on group) and thus changes their effect. Changing not only the size of the particles used in Nakamura, but also changing the chemical identity of the Nakamura silica (along with its associated properties) changes the Nakamura invention. One of ordinary skill in the art would not modify Nakamura in such a way.

Applicant on the other hand utilizes an inorganic spherical particle that is present in a particle size distribution range of 5 to 25 microns, and which is quite different than the Nakamura material. The large sized particles employed by Applicant provide a "ball bearing" effect when applied to the skin. In contrast the 0.2 micron powder of Nakamura is so fine that the particles are prone to cake on the skin.

Abe concerns a discovery that a partly neutralized product of an alkali silicate grows into a spherical particle if a carboxymethyl cellulose of predetermined degree of etherification is used in partly neutralizing the silicate.


The Abe reference indicates that the silica obtained by this process has a primary particle size of from 0.2 to 50 microns. Accordingly, the Abe material has an average particle size that is substantially greater than the maximum average particle size limitation of Nakamura. Thus, it is clear that the silica of Abe cannot be utilized in the Nakamura composition because it does not have trimethyl- or dimethylsilylated hydrophilic hydroxy groups and is not a microfine material as required by Nakamura. There is absolutely no suggestion in either Nakamura or Abe to one of ordinary skill in the art to make the substitution of the Abe silica for the Nakamura silica. Such a conclusion is a hindsight reconstruction of the present invention.

For all of the reasons set forth above, it is respectfully submitted that the claims of the present invention are patentable over the cited combination of references and are in condition for

allowance. If there is any item that the Examiner would like to discuss prior to passing this application to allowance, please do not hesitate to contact the undersigned attorney.

September 21, 2004

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